



0212.67615

PATENT APPLICATION

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Timothy Baker)
)
Serial No.: 10/648,048)
)
Conf. No.: 3223)
)
Filed: 08/26/2003)
)
For: POWER HAND TOOL RIGHT)
ANGLE ATTACHMENT HAVING A)
LIGHT SOURCE WITH A SELF-)
GENERATING POWER SUPPLY)
)
Art Unit: 3724)
)
Examiner: Choi, Stephen)

I hereby certify that this paper is being deposited with the United States Postal Service as FIRST-CLASS mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this date.

Date

Attorney for Applicant

Registration No. 26174

TRANSMITTAL OF REPLY BRIEF

MS Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Transmitted herewith:

(X) Reply Brief Pursuant to 37 CFR §§ 41.41 with respect to the Examiner's Answer mailed on November 3, 2006.

No fee is required for filing this Rebuttal Brief.

(X) The Commissioner is hereby authorized to charge any additional fee which may be required, or credit any overpayment to Deposit Account No. 07-2069. Should no proper payment be enclosed, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 07-2069. (One additional copy of this Notice is enclosed herewith.)

Dated: January 3, 2007

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1/3/07
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REPLY BRIEF PURSUANT TO 37 CFR § 41.41

Not unexpectedly, the Examiner's Answer restates the rejections that have been made during prosecution. While the examiner has written a response to applicant's arguments, the response ignores applicant's entire discussion of recent precedent from the Court of Appeals for the Federal Circuit regarding improper hindsight reconstruction and lack of motivation for combining the references relied upon by the examiners.

It is submitted that reliance upon the 1971 case of *In re McLaughlin* from the CCPA in support of the notion that hindsight reconstruction is proper "so long as it takes into account only knowledge which was within the level of

ordinary skill at the time the claimed invention was made and does not include knowledge gleaned only from the applicant's disclosure" is totally misplaced.

The CAFC decision of *In re Kahn*, 441 F3d 977, more accurately sets forth the current state of the law regarding combining references and establishing motivation to do so, and for the first time explains the Federal Circuit motivation test in the context of both *Graham* and *Dann v. Johnston*. After quoting from *Dann v. Johnston*, the court in *Kahn* explains that "[b]y requiring the Board to explain the motivation, suggestion, or teaching as part of its prima facie case, the law guards against hindsight ... which advances Congress's goal of creating a more practical, uniform, and definite test for patentability." (This decision is discussed more extensively in applicant's appeal brief.)

While many examiners may not be conversant with current CAFC decisions, and continue to rely upon outdated precedent to justify their usual and accustomed analysis and conclusions, it is submitted that the Board does not have the luxury of ignoring relevant and current CAFC decisions.

In *Kahn*, the court noted that "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.

Here, in this application the examiner has clearly used improper hindsight reconstruction to reject these claims. Not only is there a lack of motivation to combine *any* of the cited references that are relied upon by the examiner, the examiner admits that the references themselves need to be *modified* as part of the combination. There is no motivation for the combinations or the modifications to the combinations except for the vague, conclusory statements that "it would have been obvious to one of ordinary skill in the art" to do so. The examiner further states that not only would it have been obvious to one of ordinary

skill in the art at the time that the invention was made to provide a lens taught by Wu on the *modified* device of Maier, but *that the lens itself had to be modified* to employ a lighting assembly as taught by Anderson.

It is submitted that there is no motivation supplied by any of these references to combine them with the others, and there is no motivation to *modify* them in the manner suggested. It can only be done as a result of using the applicant's claims as a roadmap to locate features that purportedly meet the claims.

Applicant continues to believe that claim 1 is not taught or suggested by Maier or Anderson or Kopras, or the other references of record, applied singularly or in any combination with one another. The examiner states that Maier shows an *attachment* for a power driven wrench. It is still believed that this is a mischaracterization of what is disclosed in Maier inasmuch as it is not an attachment, but is in fact a power driven wrench as its title explicitly states.

The examiner's response includes the statement that Anderson "clearly teaches that providing a generator and lighting assembly for use with a power driven tool is well known knowledge...". It is believed that this misses the point that it is a pneumatic power driven *tool* rather than an *attachment* for a tool. The examiner's subsequent statement that "applicant's background of the invention clearly admits that such knowledge was well known within the level of ordinary skill at the time the claimed invention was made" also misses the point that while a generator and lighting assembly has been provided on a *tool*, it has not been provided on an *attachment* for a tool. It is not taught or suggested by Maier or Anderson or Kopras.

The examiner states that Anderson shows a generator and light for a power tool similar to that of Maier and that "obviously one of ordinary skill in the art would add such a light to the device of Maier." It is believed that this

statement is largely irrelevant for the reason that adding a light to Maier still does not teach or suggest a right angle *attachment* for a power hand tool as is claimed. It is also a conclusory statement that is not supported by any reference to prior art and is therefore believed to be improper.

With regard to lenses, the examiner's response states "The examiner respectfully directs appellant's attention to Col. 5, lines 34-35 where Anderson teaches 'a retainer 62 for securing the face plate and lens in place'. Anderson clearly states that 'a face plate' is not 'lens' rather they are separate elements of the device." With all due respect, the examiner's quoted portions of Anderson does not support his conclusion. While Anderson mentions the word lens, the drawing shows only a single element, namely, the face plate 60. The face plate is not a lens and in fact does not cover the lamps 54, inasmuch as the lamps are located in the cutouts 70. More particularly, the specification at col. 5, lines 50-62 states that the preferred embodiment of the face plate is made of aluminum and specifically shows and describes cutouts 70 for permitting light to be directed outwardly.

Neither Maier nor Anderson nor Kopras teach or suggest a lens in the housing adjacent said light producing device for admitting light to the exterior of said housing toward a tool attached to said distal end. Therefore, the final element of claim 1 is not taught or suggested and the claim should be allowed.

CONCLUSION

The dependent claims necessarily incorporate the features of the claims from which they depend in addition to defining other features and/or functionality and are therefore believed to be in condition for immediate allowance. This is particularly true with regard to claims 6-10 which depend from

allowed claim 5. If the rejection of claim 1 is reversed, claims 2-4 should also be allowed.

For the above reasons, applicant requests the Board to reverse the outstanding rejections. The application should then be permitted to pass to allowance.

Respectfully submitted,

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